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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,966	08/18/2003	Paul Slovick	575.040	4160
35195	7590	12/29/2006	EXAMINER	
FERENCE & ASSOCIATES			MAI, TRI M	
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PITTSBURGH, PA 15143			PAPER NUMBER	
			3781	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/29/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/642,966

Applicant(s)

SLOVICK, PAUL

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19, 21 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-19, 21 and 27-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. The drawings filed on September 25, 2006 have been disapproved.

The original disclosure does not teach the specificities, e.g., size, shape, dimension, of portions the rearward extent, of portions 150, 160 and 170. Specifically, the original shown portion 150 as a planar rather than having a protruding portion shown in the top view of Fig. 6. Furthermore, it seems that the drawing is inconsistent with the specification where portion 150 is offset and being as closed as feasible to the plane of bumper 70, pg. 13, ln. 11-13. Furthermore, the original disclosure does not teach the thickness of portion 170 in fig. 7.

2. In view the disapproval of the drawings, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the movement about the horizontal and vertical axes (cl. 13), the material extending past the lug (cl. 13), the specificities of the extent of the material about 240 degrees and 360 degrees (cl. 14-17), the movement of the tire above the ground and the tire contacting the ground, the support of at least a major portion, the length of the lug less than the length of the supporting material (cl. 29), the electrical winch (claim 33) must be shown or the feature(s) canceled from the claim(s).

The device in Fig. 3 is inoperative because portion 130 is connected to the front side of portion 100 and portion 150 is connected to the back of portion 130. This arrangement would cause the device inoperative since portion 150 would interfere with portion 100 when portion 130 is rotated upward. A close detail view of the connection between 130 and 100 and portion 150 and 130 must be shown.

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claims 13, 15-19, 21, and 27-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6631834 in view of Jozefczak et al. (5186371). Claims 1-5 of U.S. Patent No. 6631834 teaches the tire including at least one lug and the material as claimed. Claims 1-5 of U.S. Patent No. 6631834 meets all claimed limitations except for the movement about horizontal and vertical axes. It would have been obvious to one of ordinary skill in the art to have the tire support capable of movement about horizontal and vertical axes as taught by Jozefczak to enable one to bring down the tire easily.

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4. Claims 27-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not teach the support is attached to the distal end.

5. Claims 13-19, 21, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jozefczak et al. (5186371) in view of anyone of JP 258755, JP 315351, and Kennedy (1864829). Jozefczak teaches a tire support capable of movement through a plurality of positions about vertical and horizontal axes. Jozefczak meets all claimed limitations except for the mounting comprising the lug and the material extending past the lug supporting the tire.

Anyone of JP'755, JP 315351, and Kennedy teaches that it is known in the art to provide a mounting having a material passing a lug. It would have been obvious to one of ordinary skill in the art to provide a mounting having material passing a lug in Jozefczak as taught by anyone of JP'755, JP 315351, and Kennedy (note spinner and the lug at 32 in Fig. 15; page 3, ln. 60-61) to provide an alternative mounting means.

6. Claims 13-19, 21, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable Jozefczak in view of Hansen. Jozefczak teaches a tire support capable of movement through a plurality of positions about vertical and horizontal axes.

Hansen teaches that it is known in the art to provide a mounting having a material passing a lug (col. 5, ln. 30). It would have been obvious to one of ordinary skill in the art to provide a

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mounting having material passing a lug in Jozefczak as taught by Hansen to provide an alternative mounting means.

Regarding claims 14-17, it would have been obvious to one of ordinary skill in the art to provide the circumference about 240-360 in the tire support of Hansen to provide the desired circumference of the material.

7. Claims 13-19, 21, and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Mrozowski et al. (5183192), or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Mrozowski et al. (5183192) in view of Hansen or Kennedy. Mrozowski teaches a mounting movable about vertical and horizontal axes, and portion 28 as shown project past the lug 34.

Regarding claim 27, note that there is a plurality of arm portions 18a, 18b and portion 30 is mounted to the distal ends of any of these pivoting arms.

To the degree it is argued otherwise, it would have been obvious to one of ordinary skill in the art to provide portion 28 pass the lug 30 to enable one to mount the tire easily.

Furthermore, it would have been obvious to one of ordinary skill in the art to provide the mounting of either Hansen or Kennedy in Mrozowski to provide an alternative mounting means.

8. Claims 13-19, 21, 27-31, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newbill (6659318) in view of either JP 258755 or JP 315351. Newbill teaches a tire support capable of movement through a plurality of positions about vertical and horizontal axes. Newbill meets all claimed limitations except for the mounting comprising the lug and the material extending past the lug supporting the tire.

Either JP'755 or JP 315351 teaches that it is known in the art to provide a mounting having a material passing a lug. It would have been obvious to one of ordinary skill in the art to

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provide a mounting having material passing a lug in Newbill as taught by either JP'266 or JP'755 to provide an alternative mounting means.

Regarding claim 31, note the means 22 or 41.

9. Claims 13-19, 21, 27-31, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newbill in view of Hansen. Hansen teaches that it is known in the art to provide a mounting having a material passing a lug (col. 4, ln. 35). It would have been obvious to one of ordinary skill in the art to provide a mounting having material passing a lug in Newbill as taught by Hansen to provide an alternative mounting means.

Regarding claims 14-17, it would have been obvious to one of ordinary skill in the art to provide the circumference about 240-360 in the tire support of Hansen to provide the desired circumference of the material.

Regarding claim 31, note the means 22 or 41.

10. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newbill rejection as set forth above in paragraphs 8 and 9, and further in view of either Klein (4047629) or Kennedy (1864829). It would have been obvious to one of ordinary skill in the art to provide winch with a cable as taught by either Klein (note portion 22) or Kennedy (pg. 3, ln. 120-125) to provide an alternative means for holding the pivot arm.

11. Claims 13-19, 21, and 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newbill in view of Kennedy. Kennedy teaches that it is known in the art to provide a mounting having a material passing a lug (note spinner and the lug at 32 in Fig. 15; page 3, ln. 60-61). It would have been obvious to one of ordinary skill in the art to provide a mounting

having material passing a lug in Newbill as taught by Kennedy to provide an alternative mounting means.

Regarding claim 31, note the means 22 or 41.

Regarding claim 32, it would have been obvious to one of ordinary skill in the art to provide winch with a cable as taught by Kennedy (pg. 3, ln. 120-125) to provide an alternative means for holding the pivot arm.

12. Applicant's arguments have been fully considered but they are not persuasive.

With respect to the drawings, as set forth above, the new drawings contain new matters. In view of the disapproval of the new drawings, the drawing objections are maintained. Applicant is suggested to file a petition to have the new drawings entered or to have the drawing objections overturned.

The double patenting rejection stands. It is noted that the original restriction requirement in the original disclosure was made between 1) Group 1 drawn to an apparatus for carrying a spare tire hingedly mounted to a vehicle and 2) Group 2 drawn to a tire support for carrying a spare tire on the grounds that claim Groups 1 and 2 were related as Combination/Sub-combination claims and that the claims drawn to the sub-combination had separate utility and that the claims drawn to the sub-combination did not require the particulars of the sub-combination as claimed. Applicant elected claims directed to an apparatus for carrying a spare tire hingedly mounted to a vehicle and these claims have been prosecuted. However, in this instant divisional case, the claims are not directed to the tire support as originally set forth in the parent case. Applicant amended the claims during prosecution so that the claims are now are

directed to an apparatus for carrying a spare tire hingedly mounted to a vehicle that was originally prosecuted.

The 112, new matter rejection stands, portion 150 is mounted not at the distal end. It is spaced from the distal end of portion 130 as shown in Fig. 3.

With respect to the prior art, applicant asserts that the tire in Mrozowski flips and thus it cannot mount the tire in any positions. It submits that the term “any positions” is broad. Furthermore, the claim fails to set forth the positions of what particular element. In this case, when the support is in the position of Fig. 1. The tire can be mounted in any position since the conical portion 28 can allow the tire to rotate thus, the tire can be mounted in any position as claimed. Furthermore, the tire in Mrozowski can be mounted during the movement of device about the rotation about portion 12, and even, the tire can be mounted backward in the position of Fig. 2.

Furthermore, it is noted that the claims must be distinguished from the prior art in term of structure rather than function. In re Danly, 263 F.2d 844, 847(CCPA 1959). Furthermore, apparatus claims cover what a device is, not what a device does, Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F. 2d 1464, 1469 (CCPA 1935). See MPEP 2114. In this case, the functionality with respect to the tire can be mounted in any positions does not impart any structure over the device in Mrozowski.

With respect tot the rejection of Mrozowski et al. (5183192) in view of Hansen or Kennedy. Applicant rehashes the same arguments that the device of Mozowski flips and thus it cannot mount the tire in any positions. This has been addressed above. Furthermore, Hansen teaches that it is known in the art to provide a mounting having a material passing a lug (col. 4,

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ln. 35), and Kennedy (note spinner and the lug at 32 in Fig. 15; page 3, ln. 60-61). Thus, to provide the mount of either Hansen or Kennedy would have been obvious.

With respect to claim 27, note that there are two pivoting arms 18b and tow pivoting arms 18a and the support is mounted to the distal ends of any of these arms.

With respect to the rejection of Jozefczak in view of JP'755, JP' 351 and Kennedy, and Hansen, applicant asserts that there is the combination fails to teach the limitations of tire rotate and align with the lug. The examiner submits that anyone of JP'755, JP' 351 and Kennedy, and Hansen clearly teaches this limitations. In JP'351, note the mounting portion 7 where the tire can rotate and the alignment with the lug. That is how the tire is secured to the mounting. Applicant asserts that threaded stud extending from the tire carrier of JP 315351 is smaller than the interior opening of the tire rim and does not engage the interior opening in order to provide support for the tire. The examiner submits that the tire is not being claimed at all. The only structure that it is claimed is that the material extending past the lug, and that is being shown in JP 351 and JP 755. Furthermore, the claim does not exclude the other steps in mounting the wheels to the mounting, including, moving up and down so that the lug and engage wheels. The fact is that the mountings 17, in JP 351 and 11d in JP 755 allow the wheels to rotate and the lug are finally aligned so that the wheel is secured. In other words, the final arrangement of the tire with the mount encompasses the alignment of the wheel.

With respect to the Kennedy reference, applicant asserts that the combination is not obvious with the explanation that it would be difficult reaching the wheel well. The examiner submits that both Jozefczak and Kennedy are directed to pivotable tire carrier. Kennedy teaches a mount for smaller size tire enabling one to easily inserting bolt 32 to goes through. Thus, to

carry the tires 8 of Kennedy, it would have been obvious to one of ordinary skill in the art to use the mounting shown in Fig 15.

With respect to the Hansen reference, applicant asserts that the combination is not desirable. The examiner submits that to provide one type of mounting support for another would have been obvious. Furthermore, Hansen provide numerous reasons why the combination is attainable (col. 2, ln. 35-63). Hansen provide the clearest teaching that those ordinary skill in the art would provide an arcuate rest projecting through the circular hub opening and manually rotate for alignment (col. 5, ln. 22-32).

Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to provide one type of mounting means for another would have been obvious given the numerous reasons why the combination is attainable in Hansen as set forth above.

With respect to the rejections in view of Newbill, applicant rehashes the same arguments and these arguments have been addressed above. It is noted that the carrier of Newbill is very much similar to that of Hansen and Hansen discuss the mounting is well familiar to those skilled in the art (col. 5, ln. 22-32).

With respect to the rejections of Kennedy, as set forth above, it would have been obvious to one of ordinary skill in the art to provide winch with a cable as taught by either Klein (note

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portion 22) or Kennedy (pg. 3, ln. 120-125) to provide an alternative means for holding the pivot arm.

13. This is the RCE of the same application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571)272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tri M. Mai
Primary Examiner
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